

REMARKS

In the Office Action¹ mailed June 13, 2006, the Examiner took the following actions:

- 1) rejected claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 102(e) as being anticipated by Steiner et al., Pub. No. US 2003/0065774 ("Steiner"), and
- 2) rejected claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Steiner in view of Chidlovskii, U.S. Patent No. 6,327,590 ("Chidlovskii").

Applicants respectfully traverse the above two rejections. However, to advance prosecution of this application, Applicants propose to amend independent claims 1, 6, and 11. For example, claim 1 would be amended to recite:

the temporary search unit outputs the result of the search to the search condition item extracting means when the result of the search specifies a larger number of information services than a specified number of information services.

Claims 6 and 11 would be amended in a corresponding manner. Support for these amendments can be found in the specification and drawings at, for example, page 10, lines 10-21 of the specification and FIG. 7 of the drawings.

Applicants submit that Steiner provides no teaching of the above-described amendments to claims 1, 6, and 11. Accordingly, Steiner fails to disclose each and every element of amended claims 1, 6, and 11, and therefore cannot anticipate claims

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

1, 6, and 11. Claims 1, 6, and 11, as amended, are thus allowable over Steiner. In addition, dependent claims 2, 3, 7, 8, 12, and 13 are also allowable at least by virtue of their dependence from corresponding allowable base claims 1, 6, and 11. Applicants therefore respectfully request a withdrawal of rejection of claims 1-3, 6-8, and 11-13 under 35 U.S.C. §102(e).

Furthermore, Applicants respectfully traverse the rejection of claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. §103(a) as being obvious from Steiner and Chidlovskii. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither Steiner, Chidlovskii, nor their combination, teaches or suggests each and every feature of Applicants' claims.

As noted above, Steiner fails to teach the elements of amended claims 1, 6, and 11. Chidlovskii fails to cure this deficiency. That is, Chidlovskii also fails to teach or suggest “the temporary search unit outputs the result of the search to the search condition item extracting means when the result of the search specifies a larger number of information services than a specified number of information services” recited in independent claims 1, 6, and 11, and required by dependent claims 4, 5, 9, 10, 14, and 15. For at least this reason, Steiner and Chidlovskii therefore fail to support a *prima*

facie case of obviousness. The rejection of claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. §103(a) as being obvious from Steiner in view of Chidlovskii is thus improper and should be withdrawn.

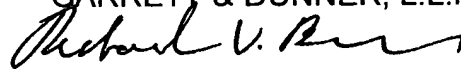
Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of pending claims 1-15.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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